

PATENT
Docket No: ST03005CIP (SURF.S4-US-CIP1)
Serial No.: 10/700,821

REMARKS

STATUS SUMMARY

Claims 1-41 are pending in the present application. Claims 23-30 are allowed. Claims 1-4, 6-15, 17, 18, 31-34 and 36-41 are rejected. Claims 5, 16, 19-22 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In this Amendment, Applicant has amended independent claims 1, 12, and 31, and has canceled without prejudice claims 4, 5, 15, 16, 34 and 35.

Applicant has considered the above-identified Office Action and cited references, and replies as set forth below to place the application in condition for allowance.

ALLOWABLE SUBJECT MATTER/SUMMARY OF EXAMINER INTERVIEW

Claims 23-30 are allowed.

Claims 5, 16, 19-22 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding the Office Action mailed September 22, 2006 ("9/22/06 Office Action"), Applicant notes that the Office Action Summary indicates that claim 34 is allowable, whereas the 9/22/06 Office Action at page 3, item 8, indicates that claim 34 is rejected under 35 U.S.C. § 103(a). On October 2, 2006, a telephonic interview transpired between Applicant's

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attorney David P. Gloekler and Examiner Broadhead, in which Applicant's attorney requested clarification as to the disposition of claim 34. The Examiner indicated that the 9/22/06 Office Action should have indicated that claim 35, and not claim 34, is objected to. Accordingly, this Amendment treats claim 34 as being rejected under 35 U.S.C. § 103(a) and claim 35 as being objected to.

Applicant respectfully submits that independent claims 1, 12 and 31 are patentable over all prior art of record and therefore continues to traverse the rejections to claims 1, 12 and 31, as discussed below. However, Applicant has made the following amendments to expedite prosecution and place the application in condition for allowance.

Claim 5 depends from claim 4, which in turn depends from claim 1. In response to the objection to claim 5, Applicant has incorporated the features recited in claims 4 and 5 into claim 1, and has canceled claims 4 and 5 accordingly.

Claim 16 depends from claim 15, which in turn depends from claim 14, which in turn depends from claim 13, which in turn depends from claim independent 12. In response to the objection to claim 16, Applicant has incorporated the features recited in claims 15 and 16 into claim 12, and has canceled claims 15 and 16 accordingly. In view of the objections to claim 5 (see previous paragraph) and claim 35 (see next paragraph), Applicant respectfully submits that the objection to claim 16 is overcome without incorporating the features of intervening claims 13 and 14 into claim 12.

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Claim 35 depends from claim 34, which in turn depends from independent 31. In response to the objection to claim 35, Applicant has incorporated the features recited in claims 34 and 35 into claim 31, and has canceled claims 34 and 35 accordingly.

In view of the foregoing, Applicant respectfully submits that the objections to claims 5, 16, 19-22 and 35 have been overcome, and therefore respectfully requests that these objections be withdrawn. Furthermore, Applicant respectfully submits that as a result of the amendments made to independent claims 1, 12 and 31 in response to these objections, claims 1, 12, and 31 are in condition for allowance.

CLAIM REJECTIONS - 35 U.S.C. § 102

Claims 1, 3, 8, 9, 10, 11, 12, 13, 14, 31, 33, 38, 39, 40 and 41 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Eschenbach (U.S. Patent No. 6,211,817). Applicant respectfully traverses this rejection for the reasons set forth in Applicant's AMENDMENT IN RESPONSE TO OFFICE ACTION MAILED JANUARY 4, 2006 AND REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.112, filed June 29, 2006. Applicant respectfully submits that the pertinent prior art references of record disclose only the use of almanacs, i.e., full almanacs, and fail to disclose or suggest the use of sub-almanacs in the manner claimed in the present application.

Despite the foregoing, and to expedite prosecution and place the application in condition for allowance, Applicant has amended independent claims 1, 12, and 31 in the manner discussed

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above in connection with the objections to claims 5, 16, 19-22 and 35. Therefore, Applicant respectfully submits that this rejection is overcome.

Claims 3 and 8 – 11 depend directly or indirectly from claim 1, and therefore are patentable for at least the same reasons as regards claim 1.

Claims 13 and 14 depend directly or indirectly from claim 12, and therefore are patentable for at least the same reasons as regards claim 12.

Claims 33 and 38 – 41 depend directly or indirectly from claim 31, and therefore are patentable for at least the same reasons as regards claim 31.

In view of the foregoing, Applicant respectfully submits that claims 1, 3, 8, 9, 10, 11, 12, 13, 14, 31, 33, 38, 39, 40 and 41 are patentable over Eschenbach. Therefore, Applicant respectfully requests that this rejection be withdrawn.

CLAIM REJECTIONS - 35 U.S.C. § 103

Claims 2 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eschenbach in view of Fuchs et al. (U.S. Patent No. 6,453,237). Applicant respectfully traverses this rejection. Claim 2 depends from claim 1, and claim 32 depends from independent claim 31. Applicant has amended claims 1 and 31 in the manner discussed above. Therefore, Applicant respectfully submits that claims 2 and 32 are patentable over the combination of Eschenbach and Fuchs et al., and respectfully requests that this rejection be withdrawn.

Claims 4, 6, 15, 17, 34 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eschenbach in view of Jandrell (U.S. Patent App. Pub. No. 2003/0016170).

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Applicant respectfully traverses this rejection. Claims 4, 15 and 34 have been canceled for the reasons set forth above. Claim 6 depends from claim 1, claim 17 depends from independent claim 12, and claim 36 depends from independent claim 31. Applicant has amended claims 1, 12 and 31 in the manner discussed above. Therefore, Applicant respectfully submits that claims 6, 17 and 36 are patentable over the combination of Eschenbach and Jandrell, and respectfully requests that this rejection be withdrawn.

Claims 7, 18 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eschenbach in view of Jandrell, and further in view of Dooley et al. (U.S. Patent App. Pub. No. 2003/0212487). Applicant respectfully traverses this rejection. Claim 7 depends indirectly from claim 1, claim 18 depends indirectly from independent claim 12, and claim 37 depends indirectly from independent claim 31. Applicant has amended claims 1, 12 and 31 in the manner discussed above. Therefore, Applicant respectfully submits that claims 7, 18 and 37 are patentable over the combination of Eschenbach, Jandrell and Dooley et al., and respectfully requests that this rejection be withdrawn.

RESPONSE TO EXAMINER'S STATEMENT OF REASONS FOR ALLOWANCE

The 9/22/06 Office Action at page 5, item 14, states the following:

The prior art of record does not disclose the mobile station transmitting an acceptable level of error to the network, and determining if a sub-almanac needs to be replaced based on the acceptable level of error; transmitting an identification list to the network that includes a list of particular sub-almanacs.

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In response, Applicant generally agrees that language similar to "transmitting an identification list to the network that includes a list of particular sub-almanacs" is included in independent claims 23, 26 and 28, which have been allowed. By contrast, Applicant respectfully submits that this quoted language is not included in any of independent claims 1, 12 and 31. Moreover, Applicant respectfully submits that the quoted language is not required in any of independent claims 1, 12 and 31 to obtain patentability, in view of the objections to claims 5, 16 and 35 and in view of Applicant's discussion of these objections as set forth above.

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CONCLUSION

In light of the above Amendments and Remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

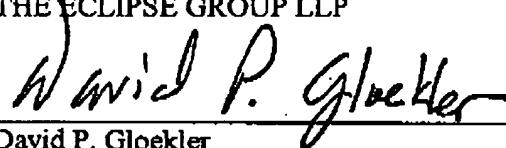
In the event that the Amendments and Remarks do not place the application in condition for allowance, Applicant respectfully requests that an Advisory Action be mailed at the earliest possible date.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Office Action.

Date: January 22, 2007

By:

Respectfully submitted,
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